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Amendment C (contd)

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REMARKS-General

1. The newly drafted independent claims 35 and 37 incorporates all structural limitations of the previously presented claim 33 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 35 to 38 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Objection of the Claim

2. Applicant respectfully submits that the newly drafted claims 35 to 38 overcome the objective of the claim 33.

Response to Rejection of Claims 34 under 35USC112

3. The previously presented claim 34 is rewritten into the claims 36 and 38 which particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112, second paragraph and that the limitations as claimed in claims 36 and 38 are disclosed and supported in lines 1 to 4 of page 7 of the specification of the instant invention so as to comply with the written description requirement as pursuant to 35USC112, first paragraph.

Response to Rejection of Claims 33 and 34 under 35USC103

4. The Examiner rejected claims 33 and 34 over Hosoda et al in view of Nakae et al in view of Applicant's disclosure. Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

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5. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)-(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Hosoda et al which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Nakae et al at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. Applicant respectfully submits that the instant invention claims **a shoe lining structure for a boot having an outer shell** wherein the shoe lining structure comprises a pair of interior lining members each of which is cut into a boot shape, wherein said interior lining members are stitched edge to edge together to form stitching edges, wherein the stitching edges of the interior lining members are further thermoplastically seamed together to form the shoe lining structure for fitting into the outer shell of the boot, wherein each of the interior lining members consists of a sheet-like waterproof and air breathable foaming cushion layer, a lining layer integrally attached to one side of the foaming cushion layer, and a cover layer integrally attached to another side of the foaming cushion layer, wherein the foaming cushion layer is made of a composition of low density polyethylene, a foaming agent including azodicarbonamide, a pigment, and additives including Zinc Oxide and Zinc Stearate integrally mixing with the low density polyethylene and the foaming agent.

7. However, the primary cited art of the instant invention is Hosoda et al which merely discloses a production of foamed polyolefin composite sheet but it fails to suggest how to construct a shoe lining structure as claimed in claim 35 and a footwear as claimed in claim 37. In addition, the other cited art neither teach any shoe lining structure nor footwear that it merely teaches a corsslinked polyolefin foam containing a high concentration of an inorganic material and process for producing the same. In other words, both cited arts just disclose a foaming material made of polyolefin but fail to teach how to substantially make

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teach how to substantially make the lining structure constructed by a pair of interior lining members each consisting of a sheet-like waterproof and air breathable foaming cushion layer, a lining layer integrally attached to one side of the foaming cushion layer and a cover layer integrally attached to another side of the foaming cushion layer. Furthermore, the two interior lining members are stitched edge to edge together to form stitching edges which are further thermoplastically seamed together.

Desirability Suggestion

8. This is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

9. In the present case, there is no such suggestion. Hosoda et al and Nakae et al perform very different types of disclosure that both cited arts merely describe a kind foaming material made of polyolefin. In fact, the only mention about shoe is in Hosoda et al, in which in column 2, lines 24-25, which recites that "this foamed composite sheet can be used broadly, for example, for roofing wall materials, floorings, various bags, shoe materials, materials used for vehicles, furnitures, etc., and in column 2, lines 48-49, which recites that "said composite sheet is highly suitable for application of traveling bags, chemical shoes, etc., which requires lightness. In Nakae et al, it never mentions any shoe or shoe lining structure for footwear.

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10. In any case, even combining Hosoda et al and Nakae et al would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). According to the Office Action dated 02/27/2007, the Examiner rejects claims 33 and 34 under 35USC103(a) as being unpatentable over Hosoda et al in view of Nakae et al in view of Applicant's Disclosure. That is, the Examiner proposes that even modifying Hosoda et al with Nakae et al would not provide the instant invention unless the cited arts must further in view of the Applicant's Disclosure.

11. Indeed, the only mention of the shoe lining structure for footwear or a footwear with a show lining structure is in applicants own specification and claims. Even in the background of the applicant's disclosure, the applicant does not mention any shoe lining structure but only discloses such shoe lining structure in the detail description of the instant invention. It is apparent that the embodiment disclosure and claim recitation of the instant invention should not be considered as prior art to combine with the cited arts, Hosoda et al and Nakae et al, to form the basis of the rejection of the claimed invention of this application. Such hindsight reconstruction is not a permissible method of constructing a rejection under 35 U.S.C. 103. In re Warner and Warner, 154 USPQ 173, 178 (CCPA 1967).

12. Accordingly, it appears that the Examiner has fallen victim to the insidious effect of a hindsight analysis syndrome where that which only the inventor taught is used against the teacher in W.L. Gore and Associates v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

13. In addition, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987). While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. In re Lesilie, 192 USPQ 427 (CCPA 1977).

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14. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection and rejection are requested. Allowance of claims 35 to 38 at an early date is solicited.

15. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



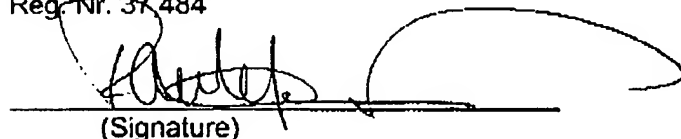
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